

Attorney Docket No.: ISPH-0526
Inventors: McKay et al.
Serial No.: 09/774,809
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REMARKS

Claims 14, 21, 22 and 28-40 are pending in this application. The Examiner has acknowledged Applicant's Amendment filed on January 6, 2003. The amendment filed on January 6, 2003 canceled claims 1-13, 15-20, and 23-27. New claims 34-40 were added, with claims 35-40 reciting SEQ ID NOs 29-41. The Examiner has suggested that a search of SEQ ID NOs: 29-41 would constitute an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed antisense sequences listed in claims 35-40. The pending claims have been subjected to a Restriction Requirement under 35 U.S.C. 121 and 37 C.F.R. 1.141. The Examiner has suggested that the inventions specifically claim antisense targeted to regions (active sites) corresponding to SEQ ID NOs:29-41, which modulate the expression of JNK. The Examiner suggests that although the antisense sequences claimed each target and modulate expression of the same gene, the instant antisense sequences are considered to be unrelated, since each antisense sequence claimed is structurally and functionally independent and distinct. It is further suggested that each sequence has a unique nucleotide sequence, each antisense sequence targets a different and specific region of JNK and each

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antisense, upon binding to the JNK gene, functionally modulates (increases or decreases) the expression of the gene and to varying degrees. It is further suggested that a search of more than one of the antisense sequences presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one of the claimed antisense sequences for examination. The Examiner has required Applicants to elect one antisense sequence of claims 35-40, to be examined with the elected invention.

Applicants respectfully traverse the instant restriction requirement.

For a proper restriction requirement the MPEP §803 requires showing: (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP §802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

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All of claims of the instant application relate to a single protein, namely JNK protein. More specifically and as acknowledged by the Examiner, each sequence functionally modulates the expression of the same structure, the JNK gene. Accordingly, each of the claims contain non-distinct components. Thus, Applicants respectfully disagree that the sequences as set forth by claims 35-40 are distinct as required by MPEP § 802.01.

Further, a search relating to only one structure, the JNK protein, would identify prior art relevant to all of the claims of the instant application and would not be overly burdensome to the Examiner. Accordingly, the instant Restriction Requirement meets neither of the criteria as set forth by MPEP §803 to be proper.

Alternatively, under MPEP §803, if search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. Accordingly, for the reasons set forth above, Applicants respectfully request reconsideration of the restriction requirement as related to the SEQ ID NOS of claims 35-40.

Reconsideration and withdrawal of this Restriction Requirement is respectfully requested. However, in an earnest

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effort to be completely responsive and to further define and
clarify the invention, Applicants have canceled claims 35-40.

Respectfully submitted,

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